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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) <b>A-4251 (191930-1050)</b>	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <b>May 30, 2006</b>		Application Number <b>08/990,973</b>	Filed <b>December 15, 1997</b>
Signature _____ Typed or printed name <b>Brooke French</b>		First Named Inventor <b>Smith, et al</b>	
		Art Unit <b>2614</b>	Examiner <b>Salce, Jason P.</b>
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input type="checkbox"/> attorney or agent of record. Registration number _____  <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. <b>58,169</b> Registration number if acting under 37 CFR 1.34 _____</p> <p style="text-align: right;"> _____ <b>Benjamin A. Balser</b> _____ _____ <b>(770) 933-9500</b> _____ _____ <b>Telephone number</b> <b>May 30, 2006</b> _____ _____ <b>Date</b></p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of <b>1</b> forms are submitted.</p>			

This collection of information is required by 36 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:

Smith, et al.

Confirmation No.: 1916

Serial No.: 08/990,973

Group Art Unit: 2614

Filed: December 15, 1997

Examiner: Salce, Jason P.

Docket No.: A-4251 (191930-1050)

For: Interactive Subscription Television Terminal

**REMARKS IN SUPPORT OF  
PRE-APPEAL BRIEF CONFERENCE**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

Applicants submit the following remarks in support of a Request for a Pre-Appeal Brief Conference.

Serial No.: 08/990,973  
Art Unit: 2614  
Page 2

### REMARKS

#### I. Status

Claims 27-32 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Welsh* (U.S. Patent No. 4,829,558) in view of *Reiter, et al* (U.S. Patent No. 4,751,578) in further view of *Boulton* (U.S. Patent No. 4,985,697). Claims 33, 39-40, and 43 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Welsh* (U.S. Patent No. 4,829,558) in view of *Kirschner, et al* (U.S. Patent No. 4,253,157) in further view of *Boulton* (U.S. Patent No. 4,985,697). Claim 46 is rejected under 35 U.S.C. 104(a) as allegedly being unpatentable over *Welsh* (U.S. Patent No. 4,829,558) in view of *Kirschner, et al* (U.S. Patent No. 4,253,157) in further view of *Boulton* (U.S. Patent No. 4,985,697) in further view of *Reiter, et al* (U.S. Patent No. 4,751,578). Claims 34-36, 38, 41, 44-45, and 47-52 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Welsh* (U.S. Patent No. 4,829,558) in view of *Kirschner, et al* (U.S. Patent No. 4,253,157) in further view of *Boulton* (U.S. Patent No. 4,985,697) in further view of *Iwashita* (U.S. Patent No. 4,928,168). Claims 37 and 42 are rejected under 35 U.S.C. as allegedly being unpatentable over *Welsh* (U.S. Patent No. 4,829,558) in view of *Kirschner, et al* (U.S. Patent No. 4,253,157) in further view of *Boulton* (U.S. Patent No. 4,985,697) in further view of *Couch, et al* (U.S. Patent No. 4,752,876). Claims 53-54 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Welsh* (U.S. Patent No. 4,829,558) in view of *Boulton* (U.S. Patent No. 4,985,697). Applicant traverses these rejections and respectfully submits that the rejections of record are clearly not proper.

#### II. Rejection of Independent Claims 27, 31, 33, 47, 53, and 54 and Boulton

Specifically, Applicant submits that the following clear legal deficiency exists in the rejection. Applicant respectfully submits that a representative claimed element, specifically among others, "**if the screen of the plurality of screens saved into memory is only accessible through other screens, indicating that the screen of the plurality of screens saved into memory is not to be deleted from memory**" is not taught by the references of record either singularly or in combination. The Office Action alleges that *Boulton* teaches this element:

Welsh ... does not teach the memory management method of determining if a screen is part of a group of screens, and only

Serial No.: 08/990,973  
Art Unit: 2614  
Page 3

saving the group of screens in RAM so that they may be directly accessed instead of continuously downloading the screens from a remote system.

Boulton discloses receiving screen data and continuously updating memory depending on the position of the current page being read, where the memory is capable of storing 10-30 pages that are linked to 3-10 pages that have already been viewed (see Column 7, Lines 8-12), thereby teaching that if the screen of the plurality of screens saved into memory is only accessible through other screens, instructing the terminal to indicate that the screen of the plurality of screens saved into memory is not to be deleted from memory.

*See Office Action, pp. 4-5.*

Applicant respectfully submits that *Boulton* fails to teach the claimed element. In *Boulton*, an electronic book publishing method is disclosed.

A number of page equivalents are ... transferred to RAM for presentation to the user. Preferably, the RAM is continually updating depending upon the position in a presentation so that 10-30 page-equivalents of subsequent text are available along with 3-10 pages of text already viewed. A lesser number of pages of additional modalities are stored to maximize the use of RAM. Thus, a user can advance a great distance in the presentation for material already stored in RAM and can backtrack *to some degree* while also being able to switch to different modalities. *The further a modality is from the current reference, the less likely a switch will be made as quickly, and thus the less need to store as many page equivalents.*

(Emphasis added). See *Boulton*, Col. 7, lines 6-13.

Serial No.: 08/990,973  
Art Unit: 2614  
Page 4

The electronic system disclosed in *Boulton* determines that more recent pages are more likely to be accessed, so it only keeps in RAM those pages likely to be accessed. If a reader is on page 350, for example, and wants to access page 4, the system of *Boulton* will not have indicated that page 4, a page that is not directly accessible, is not to be deleted from memory. The Advisory Action alleges that “[a]s stated on Page 8 of the previous Office Action, Welsh is used to teach this limitation, not Boulton.” *See Advisory Action*, p. 2. However, as indicated above, the previous Office Action uses *Boulton* to teach this limitation. *See Office Action*, pp. 4-5, 9, and 16. Therefore, Applicant challenges the Examiner’s statement that *Boulton* discloses the claimed element as clear error. Applicant respectfully submits that for at least this reason, the rejections of claims 27, 31, 33, 47, 53, and 54 are improper and should be withdrawn.

Serial No.: 08/990,973  
Art Unit: 2614  
Page 5

***CONCLUSION***

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 27-54 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER  
& RISLEY, L.L.P.**

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